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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,865	10/11/2001	John Polk	6556.0003-03000	3546

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,865

Applicant(s)

POLK, JOHN

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 127-202 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 127-202 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11 October 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 pgs. 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The examiner having noted considered the submissions in the Notices of Related Litigation filed February 08, 2002 and September 20, 2002 and Supplemental Notices of Related Litigation filed April 04, 2002, October 11, 2002, and December 12, 2002 and has not found support for the alleged allegations of unpatentability by the defendants in either (U.S. District Court for the Middle District of Pennsylvania (CV 01-2060) or (U.S. District Court for the District of Minnesota (02-CV-1231)).

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1;

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claim 127-202 are rejected under the judicially created doctrine of double patenting over claim 34-48 of U. S. Patent No. 5,946,669 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

5.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) withholding/debiting/garnishing a child support payment from the salary of an obligated parent;

B) sending the withheld amount to an accumulator agency; and

C) sending the disbursement of the withheld payment to an intermediary party.

5.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art of record:

A) the prior art for example either Hannula et al (WO 97/17678) or Bazet et al (99/03243) or McGurl et al (5,893,080 or 6,223,168) or Embrey (6,311,170 or 2002/0032651) which discloses the use of a third party as the intermediary when making payments.

B) however in regard to claims 127, 135, 143, 144, 145, 154, 163 & 164, the prior art does not teach or suggest a system in which:

A) withholding/debiting/garnishing a child support payment from the salary of an obligated parent;

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B) processing the withheld amount to at an accumulator agency as an debit-based transaction; and

C) processing the disbursement of the withheld payment as an addendum-based transaction.

Claims 128-134, 136-142, 146-153 & 155-162 are allowable for the same reason.

B) however in regard to claims 165, 174, 183, 184, 185, 193, 201 & 202 the prior art does not teach or suggest a system in which:

A) withholding/debiting/garnishing a child support payment from the salary of an obligated parent;

B) processing the withheld amount to at an accumulator agency as an debit-based transaction;

C) processing the disbursement of the withheld payment as an addendum-based transaction; and

D) terminating the withholding/debiting/garnishing a child support payment from the salary of an obligated parent when the obligation is satisfied.

Claims 166-173, 175-182, 186-192 & 194-200 are allowable for the same reason.

7. The examiner has cited prior art of interest, for example:

A) Knudson et al which disclose the use of an ACH as the intermediary when making payments.

B) Kahn et al (6,401,079), which discloses using payroll deductions and electronic transfers to make chilled support payments.

8. The examiner has considered the Information Disclosure statement filed:

A) 23 January 2002;

B) 10 April 2002;

C) 20 September 2002

D) 11 October 2002; and

E) 12 December 2002.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

01/28/03


Edward R. Cosimano
Primary Examiner A.U. 3629